



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/161,283	09/28/1998	TOMOHIRO MAEKAWA	PMS255979	7428
42798	7590	10/19/2004	EXAMINER	
FITCH, EVEN, TABIN & FLANNERY P. O. BOX 65973 WASHINGTON, DC 20035			KRUER, KEVIN R	
			ART UNIT	PAPER NUMBER

1773

DATE MAILED: 10/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/161,283

Applicant(s)

MAEKAWA, TOMOHIRO

Examiner

Kevin R Kruer

Art Unit

1773

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 29 September 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 29 September 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s): the outstanding 35 USC 112, first paragraph rejections.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: NONE.Claim(s) objected to: NONE.Claim(s) rejected: 1,2,5,8-12 and 15-23.Claim(s) withdrawn from consideration: NONE.

8. ☒ The drawing correction filed on 29 September 1998 is a) ☒ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Advisory Action

Applicant's arguments filed September 29, 2004 has been fully considered but are not persuasive. Applicant's proposed amendment has not been entered because it would new raise issues that would require further search and consideration. Specifically, the amendment would limit the composition of resin layer (A) to those that "consists of" methyl methacrylate resin or said resin with additives. The amendment would also allow the resin layer (A) to include "insoluble methyl methacrylate particles" and limit the insoluble methyl methacrylate particles of resin layer (B) to those "obtained by a one-stage polymerization." Furthermore, the amendment will not be entered because it does not place the application in better condition for appeal by materially reducing or simplifying the issues on appeal. For example, the proposed Markush group is improper.

Applicant argues that the proposed amendment would overcome the outstanding 35 U.S.C. 112, first paragraph rejection with respect to the limitation "have a uniform composition." Applicant further argues that the proposed amendment would overcome the outstanding 35 U.S.C. 112, first paragraph rejection with respect to the limitation "resin layer (A) has no insoluble methyl methacrylate particles." The examiner acknowledges that the proposed amendments would be sufficient to overcome the outstanding 35 U.S.C. 112, first paragraph rejections. However, the amendment has not been entered because it is not clear that the proposed claims, as amended, would be allowable over the prior art. The new matter introduced into the claims by the amendment of 11/04/2003 distinguished the pending claims from JP 55-034924A in view of (a) W097/301 17 and (b) Koizumi or Toritani. Said combination of references may read on the proposed claims since the new matter limitations that originally

distinguish the claims from said combination of references would be deleted by the proposed amendment. The examiner also notes that it cannot be determined without further search and consideration if the claims are allowable over the prior art as a whole, such as JP 55-034924A in view of US 5,216,096.

Applicant has submitted a rule 132 Declaration filed by Tomohiro Maekawa. The examiner believes said declaration is the declaration that applicant refers to on page 7 of the After-Final response. If it is not, Applicant is requested to file another copy of the declaration that was filed "as a follow-up to the May 5, 2004 telephone interview." The Maekawa declaration states that a one-stage procedure for preparing the insoluble resin particles is supported by reference example 2 of the present specification. The examiner agrees with said statement.

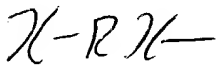
The declaration also states that the preparation of the core-shell structure particles taught in the prior art "need to consist of specific, at least two stage procedures," and that the proposed amendment "describes the insoluble methyl methacrylate particles in resin layer (B) as not core-shell structure." Said statements are noted and will be considered if the amendment is entered.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin R Kruer whose telephone number is 571-272-1510. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on 571-272-1535. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1773

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kevin R. Kruer
Patent Examiner-Art Unit 1773